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Martin G. Linihan

Name

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January 9, 2006

Date of Signature

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Robert E. Duthie, Jr.

Application No. 09/903,825

Group Art Unit 1744

Filed: June 11, 2001

Examiner: E.L. McKane

For: MICRO-ORGANISM REDUCTION IN LIQUID BY USE OF
A METAL HALIDE ULTRAVIOLET LAMP

REPLY BRIEF

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Herewith is appellant's Reply Brief in response to the Examiner's Answer mailed November 8, 2005.

In reply to the Examiner's statements in the first paragraph on page 5 of the Answer, independent claims 1 and 7 of the instant application call for defining a flow path for fluid to be disinfected/pasteurized in the body of each claim, i.e. in part c) of claim 1 and in part c) of claim 7. Accordingly, this recitation in each of the claims is entitled to be given patentable weight under the decision *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003). In other words, since this recitation relating to

disinfection/pasteurization relies upon and derives antecedent basis from the preamble, disinfection/pasteurization called for in the preambles of claims 1 and 7 should be considered a necessary component of the claimed invention.

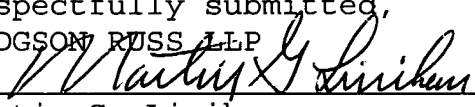
The second paragraph on page 5 of the Answer appears to ignore the decision *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) which holds that intrinsic evidence should be used to determine the ordinary meaning of claim terms. As pointed out on page 4 of appellant's Brief on Appeal, the difference between sterilization and disinfection is discussed, for example, on page 7, lines 4-19 of the instant application. The Examiner's statements in the second paragraph on page 5 of the Answer appear to rely on extrinsic evidence, outward or beyond the clear intrinsic evidence provided by the specification of appellant's application, and therefore are considered to be contrary to the guideline provided by the holding in the *Phillips* decision.

In the second paragraph on page 6 of the Answer, part b) of the combination proposed by the Examiner is completely unsupported by the prior art of record. Duthie, Jr. discloses a mercury/gallium metal halide UV lamp within a single enclosure in the form of a titanium-doped ozone free quartz envelope (emphasis added). Thus Duthie, Jr. may provide support for part a) of the Examiner's proposed combination. But where is the support for part b)? Certainly not in Duthie, Jr. wherein the UV lamp is within only a single enclosure as mentioned above. Certainly not in Wilson which does not disclose an ozone free, metallic doped quartz enclosure for a lamp.

As pointed out on page 5 of appellant's Appeal Brief, the claimed invention is characterized by the combination of a

mercury/gallium metal halide ultraviolet lamp (10) enclosed within an ozone free, metallic doped quartz envelope and an ozone free, metallic doped quartz enclosure (12) for the lamp. Duthie, Jr. discloses only the lamp which is enclosed within its envelope. Wilson does not disclose an ozone free, metallic doped quartz enclosure for a lamp. Thus, there is no prior art of record which provides support for part b) of the Examiner's proposed combination.

For the reasons set forth herein and in appellant's Brief In Support of Appeal, the Board is respectfully requested to reverse the 35 USC 103 rejection of record and to find that claims 1-10 define patentable subject matter over the art of record.

Respectfully submitted,
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